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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,683	01/20/2004	Thomas E. Broome	1001.1720101	5270
28075	7590	05/14/2007	EXAMINER	
CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420			SEVERSON, RYAN J	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/762,683	Applicant(s) BROOME ET AL.
	Examiner Ryan Severson	Art Unit 3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 February 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-36 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-36 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 January 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/12/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the amendments filed 12 February 2007.

Specification

2. The correction to the specification has been accepted and therefore the object of the previous office action is withdrawn.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1, 4-11, 22, and 25-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Vale et al. (2002/0058963).** Vale et al. (hereinafter Vale) reference discloses the invention substantially as claimed in figures 13-17.

5. For example, regarding claims 1, 22, and 33, Vale discloses an elongated tubular member (70) with a proximal segment, a distal segment (71), and an inner lumen (see figure 13). Vale also discloses a dilator tip (50) inserted into part of the distal segment (see figure 15). The dilator tip has an outer diameter greater than the inner diameter of the distal segment (see figure 13). By pulling the tip (50) proximally, the distal segment of the tubular member is expanded (compare distal segment 71 in figures 13 and 15).

Art Unit: 3731

6. Regarding claims 4 and 25, the dilator tip has a generally circular cross section.

7. Regarding claims 5 and 22, the dilator tip has a proximal section (the surface perpendicular to the inner member 11 that initially contacts the distal segment 71), a distal section (the tapered surface of the tip) and an inner lumen (see figures 13 and 15) that passes there through.

8. Regarding claim 6, the proximal section fits tightly within the distal segment (see figure 15).

9. Regarding claims 7 and 26, the distal section of the tip is tapered toward its distal end (see figure 13).

10. Regarding claims 8, 9, 27, and 28, the tubular member can expand to encompass an intravascular filter (see figure 17).

11. Regarding claims 10 and 29, the device can be used over a guidewire (25, see figure 16).

12. Regarding claims 11 and 30, the elongated tubular member can be used in a single operator exchange operation (see paragraph 73).

13. Regarding claims 31 and 32, Vale discloses an embolic protection filter (2) disposed about an elongated wire (25, see figure 16), a retrieval device (70) with proximal and distal segments (71), and a dilator tip (50) that is capable of engaging a stop (the "hub" at the proximal end of the filter directly on the guidewire, see figure 15). The proximal section of the dilator tip (as described in paragraph 5) is of greater outer diameter than that of the inner diameter of the distal segment, thereby expanding the distal segment when the proximal section of the dilator tip passes there through.

Art Unit: 3731

14. Regarding claim 33, the distal segment is formed of an elastic material, which allows it to expand to take in the filter and the dilator tip without permanent deformation.

15. Regarding claims 34-36, the dilator tip has an outer diameter greater than the inner diameter of the tubular member (see figure 15) and has a lumen extending there through.

Claim Rejections - 35 USC § 103

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3731

18. **Claims 2 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vale et al. (2002/0058963) as applied to claims 1 and 22 above, and further in view of Nilsson (5,873,851).** Vale reference does not disclose the proximal segment of the tubular member varies in thickness along its length. Attention is drawn to Nilsson reference, which teaches the wall thickness of a tubular member can have varying wall thickness (see column 5, lines 9-19) to provide a more flexible and resilient central section to assist in navigation through tortuous lumens. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary the wall thickness of the proximal segment of Vale reference along its length to provide a more flexible and resilient central section to assist in navigation through tortuous lumens.

19. **Claims 3 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vale et al. (2002/0058963) as applied to claims 1 and 22 above, and further in view of Salahieh et al. (2004/0127936).** Vale reference does not disclose a braid in the distal segment. Attention is drawn to Salahieh et al. (hereinafter Salahieh) reference, which teaches a tubular member may have a braid in its distal end (see paragraph 18) to impart flexibility to the distal portion while maintaining axial stiffness. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the braid of Salahieh in the distal end of the tube of Vale to impart flexibility to the distal portion while maintaining axial stiffness.

Art Unit: 3731

20. **Claims 12 and 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vale et al. (2002/0058963) in view of Salahieh et al.**

(2004/0127936). Vale reference discloses an elongated tubular member (70) with a proximal segment, a distal segment (71), and an inner lumen (see figure 13). Vale also discloses a dilator tip (50) inserted into part of the distal segment (see figure 15). The dilator tip has an outer diameter greater than the inner diameter of the distal segment (see figure 13). By pulling the tip (50) proximally, the distal segment of the tubular member is expanded (compare distal segment 71 in figures 13 and 15). However, Vale reference does not disclose a braid in the distal segment. Attention is drawn to Salahieh et al. (hereinafter Salahieh) reference, which teaches a tubular member may have a braid in its distal end (see paragraph 18) to impart flexibility to the distal portion while maintaining axial stiffness. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the braid of Salahieh in the distal end of the tube of Vale to impart flexibility to the distal portion while maintaining axial stiffness.

21. Regarding claim 14, the dilator tip has a generally circular cross section.

22. Regarding claim 15, the dilator tip has a proximal section (the surface perpendicular to the inner member 11 that initially contacts the distal segment 71), a distal section (the tapered surface of the tip) and an inner lumen (see figures 13 and 15) that passes there through.

23. Regarding claim 16, the proximal section fits tightly within the distal segment (see figure 15).

Art Unit: 3731

24. Regarding claim 17, the distal section of the tip is tapered toward its distal end (see figure 13).
25. Regarding claims 18 and 19, the tubular member can expand to encompass an intravascular filter (see figure 17).
26. Regarding claim 20, the device can be used over a guidewire (25, see figure 16).
27. Regarding claim 21, the elongated tubular member can be used in a single operator exchange operation (see paragraph 73).
28. **Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vale et al. (2002/0058963) in view of Salahieh et al. (2004/0127936) as applied to claim 12 above, and further in view of Nilsson (5,873,851).** The combination of Vale and Salahieh references does not disclose the proximal segment of the tubular member varies in thickness along its length. Attention is drawn to Nilsson reference, which teaches the wall thickness of a tubular member can have varying wall thickness (see column 5, lines 9-19) to provide a more flexible and resilient central section to assist in navigation through tortuous lumens. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary the wall thickness of the proximal segment of Vale in view of Salahieh reference along its length to provide a more flexible and resilient central section to assist in navigation through tortuous lumens.

Art Unit: 3731

Conclusion

29. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

30. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Severson whose telephone number is (571) 272-3142. The examiner can normally be reached on Monday - Friday 9:00 - 5:30.


32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3731

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ryan Severson
April 30, 2007



ANHTUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER

5/12/07